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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/644,513

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Bryce A. Jones

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EXAMINER

NGUYEN, TUAN HOANG

ART UNIT

PAPER NUMBER

2618

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/644,513 | <b>Applicant(s)</b><br>JONES ET AL. |  |
|                              | <b>Examiner</b><br>TUAN H. NGUYEN    | <b>Art Unit</b><br>2618             |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) 2,5 and 12-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4, and 6-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.129(a). Applicant's Pre-Appeal Brief Request for Review submission after final filed on 10/17/2008 has been entered. Applicant's argument, see applicant's remarks, with respect to the rejection(s) of claims 1, 3-4, and 6-11 under 35 U.S.C § 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Karaoguz et al. (U.S. PUB. 2002/0059434 hereinafter, "Karaoguz") in view of Lu et al. (U.S. PAT. 6,694,134 hereinafter, "Lu") and further in view of Maenpaa (U.S. PAT. 5,583,916).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-4, and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karaoguz et al. (U.S. PUB. 2002/0059434 hereinafter, "Karaoguz") in

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view of Lu et al. (U.S PAT. 6,694,134 hereinafter, "Lu") and further in view of Maenpaa (U.S PAT. 5,583,916).

Consider claim 1, Karaoguz teaches a wireless local area network (WLAN) for providing wireless telecommunications services to a multi-mode mobile station, said multi-mode mobile station being able to wirelessly communicate with a wireless wide area network (WWAN) when operating in a first wireless coverage area, said WWAN including a first data register that contains a first data record for multi-mode mobile station (fig. 2 page 3 [0038]), said WLAN comprising: at least one wireless access point providing a second wireless coverage area, said multi-mode mobile station being able to wirelessly communicate with at least one wireless access point when multi-mode mobile station operates in second wireless coverage area (fig. 3 page 3 [0041]).

Karaoguz does not explicitly show that a private branch exchange (PBX) communicatively coupled to said at least one wireless access point.

In the same field of endeavor, Lu teaches a private branch exchange (PBX) communicatively coupled to said at least one wireless access point (fig. 1 col. 6 lines 11-34 and col. 6 line 53 through col. 7 line 19).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, a private branch exchange (PBX) communicatively coupled to said at least one wireless access point, as taught by Lu, in order to provide a communication system or network and method for enabling information processing devices, such as portable computers or personal digital assistants (PDAs), to

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communicate with telephones of private and public networks via an access point of a wireless local area network (WLAN).

Karaoguz and Lu in combination, fail to teach a second data register co-located with said PBX and communicatively coupled to said first data register, wherein said second data register stores a second data record for multi-mode mobile station. When multi-mode mobile station operates in said second wireless coverage area, said second data register being able to transmit at least one mobility management message to said first data register, whereby said at least one mobility management message facilitates roaming between said first and second wireless coverage areas by multi-mode mobile station.

However, Maenpaa teaches a second data register co-located with said PBX and communicatively coupled to said first data register (col. 7 lines 55-59), wherein said second data register stores a second data record for multi-mode mobile station. When multi-mode mobile station operates in said second wireless coverage area, said second data register being able to transmit at least one mobility management message to said first data register, whereby said at least one mobility management message facilitates roaming between said first and second wireless coverage areas by multi-mode mobile station (abstract and col. 3 lines 15-44).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Maenpaa into view of Karaoguz and Lu in order to provide a method for call establishment when a call is routed to a subscriber to his home private branch exchange and to diminish unnecessary mobility management

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functions pertaining to connection establishment and sending of unnecessary signaling messages.

Consider claim 3, Lu further teaches PBX is communicatively coupled to a packet-switched network (col. 3 line 63 through col. 4 line 3).

Consider claim 4, Lu further teaches PBX is communicatively coupled to a circuit-switched telephone network (col. 3 line 63 through col. 4 line 3).

Consider claim 6, Karaoguz further teaches at least one mobility management message includes a registration message that second data register sends to first data register when multi-mode mobile station operates in wireless coverage area, registration message identifying multi-mode mobile station (page 3 [0041]).

Consider claim 7, Karaoguz further teaches at least one mobility management message includes a routing message, routing message including routing information to route a call to multi-mode mobile station (page 3 [0041]).

Consider claim 8, Karaoguz further teaches routing information includes a directory number associated with said PBX (col. 6 lines 30-34).

Consider claim 9, Lu further teaches routing information includes a directory number associated with a media gateway communicatively coupled to said WLAN via a packet-switched network (col. 7 lines 1-19).

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4. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karaoguz in view of Lu and further in view of Thornton et al. (U.S. PUB. 2002/0101860 hereinafter "Thornton").

Consider claim 10, Karaoguz, Lu, and Maenpaa, in combination, fail to teach routing information includes an Internet Protocol (IP) address of PBX.

However, Thornton teaches routing information includes an Internet Protocol (IP) address of PBX (page 32 [0300]).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Thornton into view of Karaoguz, Lu, and Maenpaa, in order for a telephony gateway intended for use, e.g., paired use, at opposite ends of a data network connection, in conjunction with at each end, e.g., a private branch exchange (PBX) for automatically routing telephone calls, e.g., voice, data and facsimile, between two peer PBXs over either a public switched telephone network (PSTN) or a data network.

Consider claim 11, Thornton further teaches routing information includes an Internet Protocol (IP) address of multi-mode mobile station (page 1 [0007]).

### ***Conclusion***

5. Any response to this action should be mailed to:

Mail Stop\_\_\_\_\_ (Explanation, e.g., Amendment or After-final, etc.)

Commissioner for Patents

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Alexandria, VA 22313-1450

Facsimile responses should be faxed to:

(571) 273-8300

Hand-delivered responses should be brought to:

Customer Service Window

Randolph Building

401 Dulany Street

Alexandria, VA 22313

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan H. Nguyen whose telephone number is (571)272-8329. The examiner can normally be reached on 8:00Am - 5:00Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Maung Nay A. can be reached on (571)272-7882882. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



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Information Consider the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tuan Nguyen/  
Examiner  
Art Unit 2618

/Nay A. Maung/  
Supervisory Patent Examiner, Art  
Unit 2618